

REMARKS

Applicant thanks the Examiner for the very thorough consideration given the present application.

Claims 1-9 are present in this application. Claim 1 is independent.

Amendments have been made to claim 1. No new matter is involved.

Reconsideration of this application, as amended, is respectfully requested.

Priority Under 35 U.S.C. § 119

Applicant thanks the Examiner for acknowledging Applicant's claim for foreign priority under 35 U.S.C. § 119, and receipt of the certified priority document.

Rejection Under 35 U.S.C. § 112, 2nd Paragraph

Claims 1-9 stand rejected under 35 U.S.C. § 112, 2nd Paragraph. This rejection is respectfully traversed.

The Examiner has set forth certain instances wherein the claim language lacks antecedent basis or is not clearly understood.

In order to overcome this rejection, Applicant has amended claim 1 to correct each of the deficiencies specifically pointed out by the Examiner.

Applicant respectfully submits that the claims, as amended, particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

Rejections under 35 U.S.C. § 103

Claims 1, 2, 4 and 6-9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 2,505,057 to Middler in view of U.S. Patent 5,601,377 to Ohya and further in view of U.S. Patent 5,397,145 to Kobluk. This rejection is respectfully traversed.

Because the rejection is based on 35 U.S.C. §103, what is in issue in such a rejection is "the invention as a whole," not just a few features of the claimed invention. Under 35 U.S.C. §103, "[a] patent may not be obtained if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." The determination under §103 is whether the claimed invention as a whole would have been obvious to a person of ordinary skill in the art at the time the invention was made. See In re O'Farrell, 853 F.2d 894, 902, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988). In determining obviousness, the invention must be considered as a whole and the

claims must be considered in their entirety. See Medtronic, Inc. v. Cardiac Pacemakers, Inc., 721 F.2d 1563, 1567, 220 USPQ 97, 101 (Fed. Cir. 1983).

In rejecting claims under 35 U.S.C. § 103, it is incumbent on the Examiner to establish a factual basis to support the legal conclusion of obviousness. See, In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. F-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. Note, In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not

make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

A showing of a suggestion, teaching, or motivation to combine the prior art references is an "essential evidentiary component of an obviousness holding." C.R. Bard, Inc. v. M3 Sys. Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." See In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999).

Moreover, it is well settled that the Office must provide objective evidence of the basis used in a prior art rejection. A factual inquiry whether to modify a reference must be based on objective evidence of record, not merely conclusory statements of the Examiner. See, In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

Furthermore, during patent examination, the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). If the PTO fails to meet this burden, then the Applicant is entitled to the patent. Only when a *prima facie* case is made, the burden shifts to the applicant to come forward to rebut such a case.

Additionally, it is well settled that the Examiner may not pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve Inc., 796 F.2d 443, 448, 230 USPQ 416, 419 (Fed. Cir. 1986), cert. denied, 484 U.S. 823 (1987) and In re Kamm, 452 F.2d 1052, 1057, 172 USPQ 298, 301-2 (CCPA 1972), and obviousness cannot be established by locating references which describe various aspects of appellant's invention without also providing evidence of the motivating force which would impel one skilled in the art to do what appellants have done. Ex parte Levengood, 28 USPQ2d 1300, 1302 (Bd. App. & Int. 1993).

Applicant respectfully submits that there are several reasons why this rejection fails to make out a *prima facie* case of obviousness of the claimed invention.

The Office Action uses as the base reference, a patent to Middler which discloses a child's vehicle having a "non-centering driving action." (col. 1, lines 1-5). Middler states that it is an object of the invention to provide a drive shaft in the form of a front axle having crank throws formed in the length thereof, to mount the front wheels on spindles outwardly and axially of the ends of the axle and to connect at least one of these spindles with the axle through a universal joint of economical and reliable construction. (Col. 1, lines 12-19).

In col. 3, lines 21-37, Middler discloses a universal joint of economical and reliable construction is composed of two yoke members 23 and 24 adapted to be attached at their ends, and in normal relation to each other, to a common diaphragm 25 which may be made of leather or rubber or other flexible material. The yoke 23 has a central collar to receive crankshaft 6 and the yoke terminates in a driving stub axle 26 having an end of other-than-round shape, e.g., square or other rectangular cross-section. The stub axle 26 extends freely through spindle 12 and thorough a similarly-shaped slot in a wheel plate 27 which is rigidly secured to wheel 11's exterior surface. Rotation of crankshaft 6 causes rotation of stub axle 26 and consequent rotation of wheel 11. The universal joint permits steering of the wheel during rotation.

Middler's universal joint of economical and reliable construction does not disclose or suggest (1) a sub-assembly including a clasp having openings or (2) a cross link, two legs of which are fitted into the openings in each respective

clasp that is mounted on the end of the drive bar or (3) a cross link the other two ends of which are fitted into respective openings in another respective clasp attached to each wheel of the vehicle. Middler's universal joint merely discloses two yokes 23 and 24 that are connected to each other by a flexible diaphragm 25. Moreover, the Office Action does not identify what elements in Middler that it considers the two separately recited clasps to be, thus tacitly admitting that Middler does not disclose such features.

Applicant also respectfully disagrees with the assertion in the sentence bridging pages 3 and 4 of the office Action that the center part of Middler's steering bar 16 surrounding opening 18 includes a U-shape. In order to have a "u-shape," one side has to be open. Middler's steering bar portion adjacent opening 16 does not have a U-shape because it is not open on one side.

Thus, it appears that the base reference is devoid of many of the features recited in claim 1.

In an attempt to remedy these deficiencies, the Office Action turns to Ohya, which discloses a universal joint for an automobile that connects directly, via circular opening 20, with a steering shaft to connect a first steering shaft with another steering shaft in line with the first steering shaft. One steering shaft is located in a circular opening 20 in one yoke 12 and another steering shaft is located in opening 20 in the other connected yoke 12, the two yokes 12, shown in Fig.13, being connected to each other by cross 14.

However, the Office Action fails to provide objective factual evidence that one of ordinary skill in the art would be properly motivated to replace Middler's toy car universal joint of economical and reliable construction that connects Middler's crank shaft 6 with Middler's wheel stub axle 26, with the automobile cross-type universal joint of Ohya that is disclosed as connecting separate portions of an automobile steering column. Ohya's universal joint is not disclosed for use with pedal driven toy cars nor is it even disclosed as connecting a pedal operated crankshaft to a wheel axle. Instead it is disclosed as being used as part of an automobile steering column that conventionally has a plurality of steering shafts and is bent at each universal joint.

Middler does not have a steering column made up of a plurality of individual steering column shafts so one of ordinary skill in the art would not be expected to look to Ohya to modify Middler. Moreover, Applicant respectfully submits that one of ordinary skill in the art would have no incentive to look to Ohya's steering column universal joint for automobiles to modify Middler's crank shaft to wheel axle universal joint for a number of reasons.

Firstly, Ohya does not disclose that its universal joint is designed for use in anything other than a multi-part steering column. Ohya does not disclose that its universal joint is for use in connecting a crank shaft and a wheel axle. For this reason alone, the Office Action does not provide objective factual

evidence that one of ordinary skill in the art would turn to Ohya to modify Middler's crank shaft-wheel axle joint.

Secondly, Middler's crank shaft-wheel axle universal joint is disclosed as being of economical and reliable construction and does not appear to be in need of modification. In other words, it is not shown to be unreliable and the Office Action fails to provide any evidence that it is uneconomical or unreliable or otherwise needs to be modified.

Moreover, if the proposed modification of Middler as suggested by the Office Action occurs, Middler's universal joint would have to be completely replaced and one of ordinary skill in the art would not have any incentive to completely redesign a system that is disclosed as of economical and reliable construction. The Office Action does not explain why one of ordinary skill in the art would have an incentive to completely redesign Middler when Middler appears to work reliably well and appears to have no need to be redesigned to work properly.

With regard to the issue of motivation, the Office Action merely postulates that if the proposed substitution of Ohya's universal joint were made, that this would result in a sturdy universal joint structure that effectively transmits torque between the drive bar and wheels. Applicant respectfully submits that this is nothing more than a broad conclusory statement and does not constitute objective factual evidence of a clear and

particular teaching that would motivate a skilled worker to make the proposed substitution. See In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999). In this regard, the Office Action provides no objective factual evidence that Middler's universal joint is not a sturdy structure or that it does not effectively transmits torque between Middler's drive bar and its wheels.

A fair, balanced view of these two references reveals that neither reference provides objective factual evidence that one of ordinary skill in the art would be motivated to do away with Middler's toy car drive-shaft to wheel axle joint and replace it with an automobile universal joint of Ohya that is not disclosed or designed to be applied to a drive shaft to wheel axle type joint and have to redesign the overall drive train of Middler. Applicant respectfully submits that the only motivation to do make the suggested modification of Middler is hindsight reconstruction of Applicant's invention based solely on Applicant's own disclosure, which cannot properly be used against Applicant.

The Office Action continues to propose further modifications of Middler because the Middler-Ohya reference combination still lacks positively recited features of claims 1, 2, 4 and 6-9, namely, a respective L-shaped rotational element fastened to the ends of the clasp of the wheel into which are fitted to the ends of a steering bar that has an open-ended U-shaped part in the center designed to accommodate a steering axle, one end of which is bent into an L

shape and the other end of which is connected to a steering wheel of the vehicle.

To provide these missing details, the Office Action turns to Kobluk, whose velocipede steering mechanism differs significantly from that of Middler in a number of aspects, including that the pedal shaft is far removed from the wheels and acts through a further mechanism to propel the vehicle, has L-shaped crank arms to which Kobluk's tie rod assembly 70 is pivotally secured. Kobluk also differs from Middler in that Middler's tie rod assembly (steering arm 15) is not connected to its universal joint, as is Kobluk's. Kobluk's tie rod is directly connected to its universal joint 58. So, in order to modify Middler, as suggested, one would have to do away with even more structural features of Middler, including the kingpins 13, the kingpin brackets 4, and the kingpin receiving portions 5.

The alleged motivation to do this is the broad, general purpose of decreasing the number of parts requiring assembly in the system, which does not really apply to Middler who has a minimum of system elements as it is, and which does not provide objective factual evidence of proper motivation to completely disassemble Middler's toy car and selectively replace portions of its steering mechanism that may not work as reliably or be as economical as Middler's steering assembly to achieve a mechanism that may or may not have fewer parts than does Middler.

Even with this last proposed modification, the Office Action is still not finished. The Office Action then takes Official Notice that securing objects together with screw attachments is desirable and that securing the supports of Middler with screw attachment elements would be obvious to effectively secure them to the vehicle. Applicant respectfully disagrees. While securing certain parts together with screws may be conventional in certain circumstances, this does not mean that securing parts together is desirable in all circumstances, including in toy vehicles in general or in the instance of steering system supports for self-propelled toy vehicles.

Moreover, the Office has to provide objective factual evidence of this speculative conclusion to support a rejection. See the decision in "In re Lee," cited above. Applicant respectfully traverses this rejection on this basis alone, i.e., for the failure to provide objective factual evidence that securing objects together with screw attachments is desirable. In fact, Applicant respectfully requests that the Office provide Applicant with objective factual evidence of this principle with respect to which Official Notice has been taken.

Furthermore, the Office Action does not point out what support features of Middler are obvious to secure to what elements in Middler, leaving that to speculation, which is not a proper basis for a rejection. It is well settled that a rejection under 35 U.S.C. §103 cannot properly be based on speculation but must be based on objective factual evidence of record. See, In re Warner, 379

F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968). See, also, In re GPAC, Inc., 35 USPQ2d 1116 at 1123 (Fed. Cir. 1995) and Ex parte Haymond, 41 USPQ2d 1217 at 1220 (Bd. Pat. App. & Int. 1996).

Accordingly, Applicant respectfully submits that the Office Action fails to make out a *prima facie* case of proper motivation to modify the base reference in view of the secondary references, as suggested, fails to provide enough details so that one of ordinary skill in the art would know what aspects of each reference are being modified to result in the claimed invention, fails to provide objective factual evidence to support certain aspects of the rejection, as discussed above, and, thus, fails to make out a *prima facie* case of obviousness of the claimed invention.

Reconsideration and withdrawal of this rejection of claims 1, 2, 4 and 6-9 under 35 U.S.C. §103(a) is respectfully requested.

Claim 3 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 2,505,057 to Middler in view of U.S. Patent 5,601,377 to Ohya and further in view of U.S. Patent 5,397,145 to Kobluk and further in view of U.S. Patent 6,105,982 to Howell et al. ("Howell"). This rejection is respectfully traversed.

Initially, Applicant notes that this rejection is improper because the Middler-Ohya-Kobluk reference combination is improper at least for the reasons

stated above. Moreover, Howell is not applied to remedy the aforementioned deficiencies on the Middler-Ohya-Kobluk reference combination. Accordingly, even if the aforementioned Middler-Ohya-Kobluk reference combination were modified as suggested, it would not render the invention of claim 3 obvious.

Howell is relied on to disclose an electric drive system for a toy vehicle. The Office Action states that Howell discloses an electric motor drive system 130, 132 that drives a smooth drive bar by gear 134. Applicant respectfully submits that merely stating this does not make it so. Applicant has reviewed Howell and cannot find any disclosure of a smooth drive bar. The Office Action does not identify where such a drive bar is explicitly shown by Howell or discussed in those words by Howell. Moreover to be inherently disclosed, something must be necessarily present, not just probably or possibly present. The mere fact that something *may* result from a given set of circumstances is not sufficient. In re Oelrich, 212 USPQ 323, 326 (CCPA 1991). "Inherent anticipation requires that the missing descriptive material is 'necessarily present,' not merely probably or possibly present, in the prior art." Trintec Indus., Inc. v. Top-U.S.A. Corp., 295 F.3d 1292, 1295, 63 USPQ2d 1597, 1599 (Fed. Cir. 2002) (quoting In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)).

So, the Office Action does not clearly demonstrate that Howell discloses the recited smooth drive bar either explicitly or inherently.

Moreover, the Office Action fails to provide objective factual evidence that one of ordinary skill in the art would be motivated to modify Middler's foot operated toy car by adding an electric motor, especially in view of the fact that Middler's crank shaft is wavy and not straight, and because the Office Action does not explain where a motor would fit in Middler's relatively small car with its foot pedals so close to the axis of the wheels. The standard for obviousness is not "obvious to try", but requires objective factual evidence that the proposed modification of a reference is feasible and within the skill of one of ordinary skill in the art along with objective factual evidence of proper motivation to make the proposed modification of the base reference combination.

Moreover, Applicant respectfully notes that Howell has no such problem in fitting a motor into its vehicle because its car is designed solely for motor operation only and there are no foot pedals in the way of mounting an electric motor in Middler.

Accordingly, Applicant respectfully submits that the Office Action fails to make out a *prima facie* case of proper motivation to modify the base reference in view of the secondary references, as suggested, fails to provide enough details so that one of ordinary skill in the art would know where to locate a motor in Middler's pedal operated toy vehicle, fails to provide objective factual evidence to support certain aspects of the rejection, as discussed above, and,

thus, fails to make out a *prima facie* case of obviousness of the claimed invention.

Reconsideration and withdrawal of this rejection of claim 3 under 35 U.S.C. §103(a) is respectfully requested.

Allowable Subject Matter

The Examiner states that claim 5 would be allowable if rewritten in independent form and amended to overcome the rejection under 35 U.S.C. § 112, 2nd Paragraph.

Applicant thanks the Examiner for the early indication of allowable subject matter in this application. Claim 1 has been amended as set forth above in order to overcome the rejection under 35 U.S.C. § 112, 2nd Paragraph. However, claim 5 has not been rewritten in independent form at this time, because it is believed that independent claim 1 from which claim 5 depends is allowable.

Additional Cited References

Because the remaining references cited by the Examiner have not been utilized to reject the claims, but have merely been cited to show the state of the art, no comment need be made with respect thereto.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 46,472, at (703) 205-8000, in the Washington, D.C. area.

Prompt and favorable consideration of this Amendment is respectfully requested.

Application No.: 10/766,835
Art Unit 3618

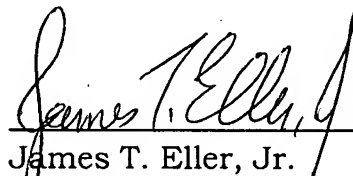
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If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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